

**REMARKS**

Favorable reconsideration of this application in light of the following remarks is respectfully requested.

Claims 1-21 are pending in the present application. Claims 1, 18 and 21 are independent.

**Information Disclosure Statements**

Applicants thank the examiner for treating the Information Disclosure Statement (IDS) filed on April 6, 2009 and for providing Applicants with an initialed copy of the Form PTO/SB/08 filed therewith.

Applicants filed an Information Disclosure Statement (IDS) on December 23, 2009, and ask that the Examiner consider that IDS and provide Applicants with an initialed copy of the Form PTO/SB/08 filed therewith, in the next communication from the USPTO.

**Claim Rejections under 35 USC §103(a)**

In the outstanding Office Action, claims 1-21 are rejected under 35 USC § 103(a) as unpatentable over U.S. Patent 6,651,120 to Chiba in view of JP 10-021796 and further in view of U.S. Patent Application Publication 2002/0161659 to Veilleux. These rejections are respectfully traversed.

Applicants respectfully submit that the outstanding final Office Action does not provide objective factual evidence in support of its statements that Chiba discloses a number of features of the claimed invention, as explained below.

Firstly, Chiba does not disclose, in col. 2, lines 40-47, assessing quantitative physical converting constraints associated with converting the stored managed data from the source representation to the presentation representation, as claimed. All that Chiba does in col. 2, lines 40-47 is to convert image data from the image obtaining device based on a conversion form received from an operation instructing unit. There is absolutely no explicit disclosure in col. 2, lines 40-47 of making any assessment of quantitative physical converting constraints associated with converting the stored managed data from the source representation to the presentation representation. Nor has the Office Action demonstrated by objective factual evidence that Chiba inherently accomplishes this claimed feature. In this regard, Applicants note that inherency may not be established by probabilities or possibilities. What is inherent must necessarily be disclosed. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir.1993). A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. *Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002).

All that col. 2, lines 40-47 discloses is that a data converting unit simply converts image data. There is no disclosure that Chiba assesses physical quantitative converting restraints associated with converting stored managed data from a source representation to the presentation, as claimed.

Nor does Chiba perform any dynamic tradeoff between the first assessment and the second (which is not even found in Chiba) assessment, which is required to serve as a basis for the claimed feature of executing the selective data conversion on a dynamic tradeoff basis between the first assessment and the second assessment. The alleged basis for Chiba performing the claimed dynamic tradeoff and for executing selective data conversion based on this dynamic tradeoff is col. 2, lines 40-60 of Chiba.

Unfortunately, all that Chiba discloses in col. 2, lines 40-60 is a simple data conversion involving an image data conversion unit that transfers image data specified by a user and instructed by the operation instruction unit to the side of the information processing device.

Clearly, there is no explicit disclosure in the relied upon portion of Chiba of performing any dynamic tradeoff between the first assessment and the second (which is not even found in Chiba) assessment, which is required to serve as a basis for the claimed feature of executing the selective data conversion on a dynamic tradeoff basis between the first assessment and the second assessment. Moreover, the Office Action does not even attempt to explain how the relied upon portion of Chiba inherently (i.e., not just possibly and not just probably, but necessarily) discloses performing any dynamic tradeoff between the first assessment and the second (which is not even found in Chiba) assessment, which is required to serve as a basis for the claimed feature of executing the selective data conversion on a dynamic tradeoff basis between the first assessment and the second assessment. The only statement presented to explain what is done in col. 2, lines 40-60 of Chiba is that the data conversion is done automatically by the data converting unit. However, this statement clearly does not even address, let alone explain, how the relied upon portion of Chiba inherently (i.e., not just possibly and not just probably, but

necessarily) discloses performing any dynamic tradeoff between the first assessment and the second (which is not even found in Chiba) assessment.

**Significantly, Chiba does not disclose storing the image in an intermediate representation, Chiba stores the image in a final representation as desired and specified by a user.**

The Office Action also admits that Chiba does not disclose (1) assessing quantitative physical storage constraints associated with storing the managed data, and (2) assessing quantitative physical converting constraints associated with converting the stored managed data from the source representation to the presentation.

Applicants respectfully submit that Chiba does not inherently contain such a disclosure, either.

In an attempt to remedy the shortcoming of Chiba, the Office Action turns to Takashi, relying on paragraph 6, lines 1-9, paragraph 20, lines 106, and paragraph 21, lines 1-8, indicating that Takashi discloses determining storage constraints and conversion constraints associated with a data and converting the data based on the determination. The Office Action concludes that it would be obvious to modify Chiba in view of Takashi to assess quantitative physical storage restraints associated with storing the managed data and assess quantitative physical converting constraints associated with converting the stored managed data from the source representations to the presentation for automatically converting image data to be transferred to an optimum file format (also referencing Takashi, Abstract, lines 1-3).

**Applicants respectfully disagree with these assertions for a number of reasons.**

Firstly, by way of background, Applicants respectfully submit, that Takashi discloses a still camera connected to a PC by an infrared link, where image files are uploaded from the PC to a memory card in the camera. Takahashi discloses determining an optimal file format on the basis of an established order of priority, established in advance (see Takashi, paragraph [0016]), where the order is set according to image quality or capacity priority, which means that either image quality has to prevail or storage capacity has to prevail. After determination of the optimal file format, a check is carried out to determine if the file at hand has this optimal file format already. If it does, the file will be forwarded to the camera. If it does not, format conversion will take place.

Secondly, Applicants respectfully submit that, in contrast with the allegation in the Office Action, Takashi does not disclose *conversion constraints*. Instead, Takashi discloses carrying out a selective conversion, but does not take into account any constraints regarding the convention, such as, for example, needed processing time (as disclosed by Applicants in paragraph [0029]).

Thirdly, Takashi does not disclose assessing quantitative physical converting constraints, or executing a conversion based on a dynamic trade-off based on constraint assessments, as claimed. In fact, in Takashi there are no conversion constraints to trade-off.

Fourthly, neither Chiba nor Takashi disclose executing the conversion before said storing, and/or after said storing, as claimed, because neither reference discloses conversion after storing.

**Nor does Veilleux provide the aforementioned features missing from Chiba and Takashi.**

**So, no matter how these three references are combined, they do not support a combination which discloses, suggests, or otherwise renders obvious the claimed invention.**

**Applicants are attaching a nine page English language translation of JP 11-219423 (filed as JP 10-21796) to Takashi and a six page JPO English language translation of Takashi . Applicants do not guarantee the accuracy of the translations but are presenting them in good faith.**

In addition, Applicants also respectfully submit that dependent claim 7 further defines over the combination of Chiba in view of Takashi and Veilleux. In more detail, dependent claim 7 further clarifies that the method is executed by consulting a rule base. Thus, the claimed invention provides an optimized document management system by executing a systematic process of performing tradeoffs based on consulting a rule base (see paragraphs [0010] and [0051] of the present application).

Examiner asserts that, with respect to claim 7, Chiba in view of Veilleux discloses the method of claim 1 executed by consulting a rule base (Chiba: Item 19 in Fig. 10). Applicants respectfully disagree with this assertion because element 19 in Chiba is merely an operation instruction unit. Its operation is explained by Chiba, as follows: "[W]hen a user specifies image data to be transferred among the image data stored in the data storing unit 13 within the image reading/displaying device 10, and also specifies, for example, a data form into which the transferred data is converted, the operation instructing unit 19 within the information processing

device 11 instructs the image reading/displaying device 10 to transfer the specified image data, and also instructs the data converting unit 18 to convert the transferred into the specified data form according to the specification. A user selection of image data and specification of the type of data after being converted are made via the user interface (UI) display unit 20.” There is no mention of a rule base found in Chiba. In fact, a key word search of Chiba fails to find the word, “rule.”

**Applicants respectfully submit that the outstanding Office Action does not respond to these arguments, thereby tacitly admitting them.**

Accordingly, none of the applied references, alone or in combination, teach or suggest the rule based features in dependent claim 7.

Accordingly, it is respectfully submitted independent claims 1 and 18 and each of the claims depending therefrom are allowable.

### **Conclusion**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert J. Webster, Reg. No. 46,472, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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Attachment: English language translation of JP 11-219423 (filed as 10-21796)  
from client— 9 pages  
JPO computer generated translation of Takashi – 6 pages